

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit	: 3725	Customer No.: 035811
Examiner	: Faye Francis	
Serial No.	: 09/844,322	
Filed	: April 26, 2001	Docket No.: 1391-CON-00
Inventors	: Casey William Norman	
	: Torquil Patrick Alexander Norman	Confirmation No.: 1969
Title	: DOLL'S CLOTHING	
		Dated: January 4, 2006

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**APPEAL BRIEF**

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The Appellants have appealed from the rejection of Claims 20-23, 25, 26 and 28-51. The Appellants submit their Appeal Brief with a check in the amount of \$500.00 under 41 CFR §41.20(b)(2).

**REAL PARTY IN INTEREST**

The real party in interest, by Assignment recorded in the USPTO records at Reel 011875 and Frame 0201 is Genie Toys, PLC, a corporation of the United Kingdom located at 25 Imperial Square, Cheltenham, Gloucestershire GL50 1QZ, United Kingdom.

**RELATED APPEALS AND INTERFERENCES**

The Appellants filed a Notice of Appeal on July 1, 2005 for U.S. Patent Application Serial No. 09/711,194 filed on November 13, 2000 (Attorney Docket No. 1391-CIP-00).

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### **STATUS OF THE CLAIMS**

The Appellants' Claims 1-19, 24 and 27 were canceled without prejudice and without disclaimer of the subject matter thereof. Claims 20-23, 25, 26 and 28-51 are rejected and on appeal. Claims 21, 22, 33, 38 and 47 are independent claims.

### **STATUS OF THE AMENDMENTS**

The following Amendments and Responses are of record: an Amendment filed December 7, 2001 in response to the Non-final Official Action dated August 7, 2001; an Amendment and Notice of Appeal filed October 10, 2002 in response to the Final Official Action dated April 10, 2002; a Request for Continued Examination filed November 11, 2002 in response to the Advisory Action of October 28, 2002; an Amendment filed June 2, 2003 in response to the Final Official Action dated February 4, 2003; an Amendment and Request for Continued Examination filed August 4, 2003 in response to the Advisory Action dated June 19, 2003; an Amendment filed December 22, 2003 in response to the Non-final Official Action dated September 24, 2003; an Amendment filed June 14, 2004 in response to the Final Official Action dated March 25, 2004; a Request for Continued Examination filed July 20, 2004 in response to the Advisory Action dated July 2, 2004; an Amendment filed December 7, 2004 in response to the Non-final Official Action dated September 7, 2004; and a Notice of Appeal filed July 12, 2005 in response to the Non-final Official Action dated May 17, 2005. A copy of the claims as they now stand is provided in Appendix A attached hereto.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

The claimed subject matter relates to a garment comprising a flexible and elastic injection molded thermoplastic elastomer doll's garment having a molded shape to fit over, in a life-like way, external surfaces of at least a portion of a doll that has articulated limbs, has a through hole that accommodates passage of a doll's head or limb(s) having a wall thickness from 1 to 3 mm. (See the Specification page 1, lines 20-23; page 2, lines 14-15; page 3, line 14; page 3, lines 27-31; and the Figures).

The claimed subject matter also relates to a garment comprising a flexible and elastic injection molded thermoplastic elastomer doll's garment having a molded shape to fit over, in a life-like way, external surfaces of at least a portion of a doll that has articulated limbs, has a through hole that accommodates passage of a doll's head or limb(s) and an average modulus of elasticity of less than  $1\text{MN/M}^2$ . (See the Specification page 1, lines 20-23; page 2, lines 1-5; page 3, line 14; page 3, lines 27-31; and the Figures).

The claimed subject matter further relates to a play set comprising a doll and a garment comprising a flexible and elastic injection molded thermoplastic elastomer doll's garment having a molded shape to fit over, in a life-like way, external surfaces of at least a portion of a doll that has articulated limbs, has a through hole that accommodates passage of a doll's head or limb(s) having either a wall thickness from 1 to 3 mm or an average modulus of elasticity of less than  $1\text{MN/M}^2$ . (See the Specification page 1, lines 1-3; page 1, lines 20-23; page 2, lines 1-5; page 2, lines 14-15; page 3, line 14; page 3, lines 27-31; and the Figures).

The claimed subject matter still further relates to a play set comprising, in cooperative combination, a doll donned and fitted with a flexible and elastic injection molded garment which is molded to be removed, dressed and refitted again over external surfaces of the doll in a life-

like way, the doll being articulated at a joint selected from the group consisting of the joints of the shoulders, elbows, knees, neck and hips, the garment has a through hole that accommodates passage of a doll's head or limb(s) and being molded from an elastomeric material selected from the group consisting of ethylene vinyl acetate copolymer, styrene-butadiene-styrene, styrene-isoprene-styrene, styrene-diene, styrene-isoprene-butylene block copolymers containing mineral oil, branched styrene copolymer, styrene butadiene rubber, styrene-butadiene triblock rubber, styrene-isoprene-styrene linear block polymer, styrene-butadiene radial block copolymer, butadiene-styrene copolymer rubber, the garment having a wall thickness from 1 to 3 mm and an average modulus of elasticity of less than  $1\text{MN/M}^2$ . (See the Specification page 1, lines 1-3; page 1, lines 20-23; page 2, lines 1-5; page 2, lines 14-15; page 3, line 14; page 3, lines 27-31; page 1 line 20 through page 2, line 3 and the Figures).

The claimed subject matter yet further relates to a doll's flexible and elastic garment which is adapted to be dressed, fitted and be removed from a doll in a life-like way, said garment comprises a flexible and elastic injection molded elastomeric copolymer material selected from the group consisting of ethylene vinyl acetate copolymer, styrene-butadiene-styrene, styrene-isoprene-styrene, styrene-diene, styrene-isoprene-butylene block copolymers containing mineral oil, branched styrene copolymer, styrene butadiene, styrene-butadiene triblock, styrene-isoprene-styrene linear block polymer, styrene-butadiene radial block copolymer, butadiene-styrene copolymer, the garment having a molded shape to fit over external surfaces of at least a portion of the doll that has articulated limbs and a wall thickness from 1 to 3 mm, said garment having an average modulus of elasticity of less than  $1\text{MN/M}^2$ , has a through hole that accommodates passage of a doll's head or limb(s). (See the Specification page 1, lines 20-23; page 2, lines 1-5;

page 2, lines 14-15; page 3, line 14; page 3, lines 27-31; page 1 line 20 through page 2, line 3 and the Figures).

### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 21-23, 25, 26, 28 and 30-34 are rejected under 35 U.S.C. §103(a) over Kramer (U.S. Patent No. 5,607,339), in view of O'Brian (U.S. Patent No. 2,944,368) and either Gross (U.S. Patent No. 5,913,708) or Wion (U.S. Patent No. 4,294,036).

Claims 20, 29 and 35-37 are rejected under 35 U.S.C. §103(a) Kramer (U.S. Patent No. 5,607,339), in view of O'Brian (U.S. Patent No. 2,944,368) and either Gross (U.S. Patent No. 5,913,708) or Wion (U.S. Patent No. 4,294,036) as applied to Claims 21-23, 25-26, 28 and 30-34 and further in view of Yasuda (U.S. Patent No. 5,928,803).

Claims 38-51, are rejected under 35 U.S.C. §103(a) over Kramer (U.S. Patent No. 5,607,339) in view of O'Brian (U.S. Patent No. 2,944,368), Yasuda (U.S. Patent No. 5,928,803) and either Gross (U.S. Patent No. 5,913,708) or Wion (U.S. Patent No. 4,294,036) as applied to Claims 21-23, 25-26, 28 and 30-34.

### **ARGUMENT**

#### *Rejection of Claims 21-23, 25-26, 28 and 30-34 under 35 U.S.C. §103(a)*

Claims 21-23, 25-26, 28 and 30-34 under 35 U.S.C. §103(a) over Kramer in view of O'Brian and either Gross or Wion.

Kramer discloses a sheet system, wherein sheets of material having selected characteristics may be formed into essentially a planar doll shape, *i.e.*, essentially two-dimensional, among other planar shapes. The characteristics of the sheet are selected so that,

when wetted, the sheet sticks to a hard surface such as a ceramic surface. This results from surface tension between the sheet and the hard surface as created by an intervening layer of water, as is shown in Fig. 3 of Kramer.

Additionally, another layer of similar planar sheet material, cut into the form of clothes, is first wetted and then laid over the doll shaped sheet. Thus, a child can form a type of doll on essentially the tiles adjacent a bathtub and vary the clothing associated with that doll. Surface tension and the intervening water layer between the doll-shaped sheet and the clothes sheets allows that system of Kramer to function in its intended manner.

In sharp contrast to Kramer, Claims 21-23, 25-26, 28 and 30-34 relate to dolls and play sets including such dolls that are not characterized as planar, but are known in the ordinary three-dimensional sense and involve doll's garments which also have a three-dimensional shape. The garments are molded in particular shapes such that they will fit over the varied three-dimensional surfaces of portions of the doll. The garments and play sets of Claims 21-23, 25-26, 28 and 30-34 do not rely on the presence of water created surface tension to achieve the fit on the doll.

The Official Action dated May 17, 2005 admits that Kramer does not disclose that the doll's garment has a through hole, an injection molded thermoplastic elastomer doll's garment, the specific thermoplastic elastomer material, a play set comprising a doll and a doll's garments wherein the doll is articulated limbs, a finish selected from the group consisting of paint, varnish and glitter, and that the garment is less than 8 cm in height.

The differences set forth above, reinforced by the Examiner's frank admissions, demonstrate that Kramer has nothing to do with the subject matter of Claims 21-23, 25-26, 28 and 30-34.

In sharp contrast to Kramer (and Claims 21-23, 25-26, 28 and 30-34), O'Brian discloses conventional doll structures and, as a consequence, one of ordinary skill in the art would have utterly no incentive or motivation to combine O'Brian with Kramer. Kramer is directed to "clothing" items that are essentially two dimensional, i.e. planar, and "dolls" that are not articulable. The clothing disclosed by O'Brian, such as that shown in Figs. 2 and 3, is shaped to "snap" its hard plastic pieces onto the non-articulable doll, as shown in Fig. 1. Such "snapping" action is a totally different mechanism to achieve positioning of the clothing relative to the doll or a doll-like shape as compared to Kramer, which relies on surface tension supplied by the presence of water.

Both of those technologies are different from each other and very different from the subject matter of Claims 21-23, 25-26, 28 and 30-34. The flexible and elastic injection molded thermoplastic elastomer doll's garments of Claims 21-23, 25-26, 28 and 30-34 are sized and shaped to fit over dolls in a life-like way, such that they are adaptable to articulable dolls. In other words, the doll's garments are donned in the same fashion that real people don their clothes. For example, jackets are donned "arms first" and dresses, trousers and skirts are "stepped into." The fact that the dolls have articulated limbs and the garments are flexible and elastic and fitted in a life-like way over the doll, is neither taught nor suggested by either Kramer or O'Brian. Thus, dolls' garments adapted for either or both of Kramer or O'Brian are not adaptable to articulable dolls as is the case of the garments of Claims 21-23, 25-26, 28 and 30-34. Thus, one of ordinary skill in the art, when attempting to design garments for articulable dolls or for dolls having articulated limbs, would have utterly no incentive to use the teachings of either Kramer or O'Brian. As a consequence, one of ordinary skill in the art would have no incentive to make the hypothetical combination.

Additionally, O'Brian fails to disclose, teach or suggest injection molded thermoplastic elastomer. The Official Action of May 17, 2005 points to Column 3, lines 54-56 of O'Brian, which is reproduced below in its entirety.

Preferably in manufacturing the doll 10 and the various articles of apparel illustrated, as well as the base utilized with this doll 10, a flat sheet 34 of any number of a number of thermoplastic materials, such as, for example, polyethylene, polystyrene or the like, is printed or otherwise similarly colored substantially as indicated in Fig. 6 of the drawings in various colors and shapes, etc. so that different portions of the sheet 34 correspond to the doll 10 and the various articles of apparel it is desired to utilize with this doll.

This portion of O'Brian is not applicable because it does not anywhere mention the word "injection". In fact, the Appellants have carefully examined every word of the O'Brian text and did not find the word "injection" at any location of that disclosure. As a result, O'Brian fails to teach, disclose or suggest injection molded thermoplastic elastomer.

Additionally, there is no mention of the term "elastomer." As a result, O'Brian does not support the disclosure of an elastomer. In fact, the Appellants have carefully scrutinized the entire text of O'Brian and the word "elastomer" never appears at any location. The clothing of O'Brian is rigid (or semi-rigid under a liberal interpretation) and clipped on, which is critical because the clip-on clothing of O'Brian is just the type of clothing that the Appellants seek to avoid. The fact that O'Brian discloses a thermoplastic material in no way means that it discloses, teaches or suggests an elastomer. By definition, thermoplastic materials are soft when warm and hard when cool. However, that in no way makes them elastic. Elasticity is a completely different concept and physical phenomenon than plasticity. The term "plastic" merely refers to the ability to be molded or modeled whereas the term "elastic" refers to the ability to recover size and shape after deformation or being easily stretched or expanded and then resuming the former shape. Reference to Webster's Dictionary makes this abundantly clear. To those of ordinary



skill in the art, the fact that Kramer mentions a modulus of elasticity of less than 750 psi means the Kramer pieces are flexible, not elastic or stretchable. Thus, O'Brian fails to either explicitly or implicitly disclose, teach or suggest "injection", "elastomer" or "injection molded elastomer" which terms are explicitly recited in the Claims 21-23, 25-26, 28 and 30-34. Therefore, even if one of ordinary skill in the art hypothetically combines O'Brian with Kramer, there is still no disclosure, teaching or suggestion of an injection molded thermoplastic elastomer. As a consequence, the combination of disclosures is non-enabling and the rejection of Claims 21-23, 25-26, 28 and 30-34 over the hypothetical combination of O'Brian with Kramer must fail.

One of ordinary skill in the art would have no incentive to make the hypothetical combination of O'Brian with Kramer as mentioned above and further in view of Gross. Gross fails to disclose, teach or suggest the cure for the deficiencies set forth above with respect to Kramer and O'Brian. There is simply no discussion of injection molding. Moreover, Gross uses a rigid core covered with an elastic skin that is not at all removable, but is partially adhered to the rigid core to facilitate selected areas where the skin may expand relative to the core to simulate changes in muscle tone or weight gain.

Gross is directed to a doll or toy figure that uses what is essentially a series of bladders that are able to expand and contract to portray weight gain or loss, muscle building, or the like. While Gross discloses a doll with articulated limbs, the bladder portions of Gross do not extend over the articulatable areas. Instead, the bladders are restricted to particular areas that do not include articulated portions. In sharp contrast, Claims 21-23, 25-26, 28 and 30-34 describe garments meant to be removed from an articulatable doll. As a consequence, even if one of ordinary skill in the art were to make the hypothetical combination of both of Gross and O'Brian

with Kramer, the resulting structure would still not result in, teach or suggest the injection molded thermoplastic elastomer doll's garment of Claims 21-23, 25-26, 28 and 30-34.

Hypothetically combining Wion would not cure the deficiencies of Kramer, O'Brian, and Gross as noted above. Thus, even if one skilled in the art combined them with Wion, the result would be structure that is far afield of the subject matter of Claims 21-23, 25-26, 28 and 30-34. Reversal of the rejection of Claims 21-23, 25-26, 28 and 30-34 is respectfully requested.

*Rejection of Claims 20, 29 and 35-37 under 35 U.S.C. §103(a)*

Claims 20, 29 and 35-37 are rejected under 35 U.S.C. §103(a) over the hypothetical combination of Kramer in view of O'Brian and either Gross or Wion as applied to Claims 21-23, 25-28 and 30-34 and further in view of Yasuda.

The Official Action of May 17, 2005 states that the "Modified device of Kramer has most of the elements of these claims but for the specific thermoplastic elastomer material." The Appellants respectfully disagree. A modified device of Kramer fails to disclose, teach or suggest much more. Those deficiencies have been clearly set forth above with respect to the earlier rejection and need not be repeated here. However, they apply with the same effectiveness.

Even if one of ordinary skill in the art were to use the various materials disclosed by Yasuda as they apply to the specifics of Claims 20 and 29 and 35-37, the result would still be structures far different from those recited in Claims 20, 29 and 35-37. For example, applying the materials of Yasuda to the "clothes" of Kramer would result in flat, planar garments designed to adhere to the flat, planar doll shaped cutouts disclosed by Kramer.

Similarly, if one of ordinary skill in the art were to use the materials of Yasuda for O'Brian, the result would be garments of the "snap-on" type having nothing to do with the

garments of Claims 20, 29 and 35-37. In fact, one of ordinary skill in the art might very well hesitate to substitute the materials of Yasuda for the specific materials disclosed by O'Brian because substitution of such materials might destroy the "snap-on" ability of those garments as contemplated by O'Brian. Thus, hypothetically combining Yasuda with O'Brian and Kramer would still fail to teach or suggest flexible and elastic garments adapted to be fitted, dressed and removed from a garment in a life-like way when the doll has articulated limbs.

Even if combined, Kramer in view of O'Brian et al. and either Gross or Wion, would fail to teach or suggest the subject matter as recited in Claims 20, 29 and 35-37. This rejection selects isolated bits and pieces of the claimed subject matter from four separate disclosures and combines them together with utterly no teachings or suggestions to do so. In order to hypothetically combine references, it is required that there be teachings or suggestions to 1) make modifications and 2) a reasonable chance of success that such modifications would be successful. Neither prong is satisfied. As previously noted, there are utterly no teachings or suggestions to combine O'Brian with Kramer inasmuch as O'Brian employs snap-on garments whereas Kramer employs surface tension caused by the presence of water. Yasuda is non-enabling with respect to what kind of doll is contemplated. This is also sharply contrasted to Gross which employs dolls that have articulations, but uses bladders that do not cover the articulations. Thus, one of ordinary skill in the art would find neither teachings nor suggestions to either make the hypothetical combinations in the first place or give rise to a reasonable expectation of success upon making such combinations. Reversal of the rejection is respectfully requested.

*Rejection of Claims 38-51 under 35 U.S.C. §103(a)*

Claims 38-51 are rejected under 35 U.S.C. §103(a) over Kramer in view of O'Brian, Yasuda and either Gross or Wion. The Appellants have already demonstrated why one skilled in the art would not combine Kramer in view of O'Brian in view of Yasuda and either Gross or Wion presented above. This alone substantiates reversal of the rejection.

The Appellants respectfully submit that Kramer does not disclose “most of the elements of these claims” as set forth in the Official Action. However, the Appellants fully agree that Kramer does not disclose an injection-molded thermoplastic elastomer doll’s garment and a doll having articulated limbs. Also, the Appellants agree that Kramer does not disclose a finish selected from the group consisting of paint, varnish and glitter, the garment is 8 cm in height or a playset including a doll, wherein the doll is articulated in a joint selected from the group consisting of shoulders, elbows, knees, neck and hips.

The Appellants do not agree that O'Brian teaches the concept of providing elastic injection molded thermoplastic elastomer doll’s garments. The Appellants have carefully examined every word of the O'Brian text and do not see the word “injection” in any location of that disclosure. Accordingly, O'Brian inherently fails to disclose, teach or suggest injection molded thermoplastic elastomer. Therefore, hypothetically combining O'Brian with Kramer still fails to disclose, teach or suggest an injection molded thermoplastic elastomer.

The same applies to “elastomer.” The Official Action helpfully refers to column 3 at lines 54-56 to support the notion that O'Brian discloses an injection molded thermoplastic elastomer. Unfortunately, that text does not support the disclosure of an elastomer. The fact that that text discloses a thermoplastic material in no way means that it discloses, teaches or suggests an elastomer. Thermoplastic materials are soft when warm and hard when cool by definition.

However, that in no way makes them elastic. Elasticity is a completely different concept and physical phenomenon than plasticity. Plastic merely refers to the ability to be molded or modeled whereas elastic refers to the ability to recover size and shape after deformation or being easily stretched or expanded and then resuming the former shape. Reference to Webster's Dictionary makes this abundantly clear. The fact that Kramer mentions a modulus of elasticity of less than 750 psi means to those of ordinary skill in the art that the Kramer pieces are flexible, not elastic or stretchable. The Appellants accordingly respectfully submit that O'Brian fails to either explicitly or implicitly disclose, teach or suggest "injection" and "elastomer," both of which terms are explicitly recited in the Claims 38-51. Therefore, even if one of ordinary skill in the art hypothetically combines O'Brian with Kramer, there is still no disclosure, teaching or suggestion of an injection molded thermoplastic elastomer as admittedly not disclosed by the Examiner in Kramer. The reliance on the word "resilient" is erroneous since that word is not at issue in any of the claims.

Moreover, one of ordinary skill in the art would not make the hypothetical combination of O'Brian with Kramer in the first place. Kramer is directed to clothing items that are essentially two dimensional, i.e. planar, while O'Brian is directed to "snap-on" clothing items. These have nothing to do with one another and operate under completely different theories of how to place clothes into a selected, desired position with respect to a doll or doll like shape. Kramer relies of the surface tension created by the presence of water, while O'Brian relies on the "snap-on" feature. These are completely different approaches that would not cause one of ordinary skill in the art to make the hypothetical combination.

In any event, both approaches are unlike that recited in Claims 38-51 and are nothing like the approach taken by the Appellants. The Appellants' injection molded thermoplastic elastomer

doll's garments are sized and shaped to fit over dolls in a life-like way. In other words, the doll's garments of the invention are donned in the same fashion that real people don their clothes. For example, jackets are donned "arms first" and dresses, trousers and skirts are "stepped into." This is not the case with Kramer which relies on surface tension supplied by the presence of water and is not the case in O'Brian which "snaps on" its hard plastic pieces. As a consequence, one of ordinary skill in the art would have no incentive to make the hypothetical combination. In any event, both references fail to disclose, teach or suggest the claimed flexible and elastic injection molded material sized and shaped to be donned in a life-like way. There is simply no such disclosure in either reference.

Further hypothetically combining Gross or Wion with the primary or secondary reference fails to cure the fatal deficiencies already described with respect to the primary and secondary references. Yasuda fails to provide teachings or suggestions that satisfy the deficiencies of the original combination of O'Brian with Kramer. Unlike O'Brian, Yasuda mentions injection molding. Such mention may be found at Column 5 in the paragraph beginning at line 40. However, injection molding is not mentioned in a context that is applicable in the hypothetical combination. Specifically, Yasuda refers to injection molded resin layers such as the layers 2A, 3 and 2B as shown in Figs. 1 – 9. Those injection molded layers/articles are then laminated with other films to form a resulting resin molded article. However, that is not what the Appellants do and not what the Appellants claim. The Appellants' garments are actually injection molded thermoplastic elastomer. Moreover, one of ordinary skill in the art would have no comprehension as to whether the laminate (not the layers) is elastic as claimed. It would be nothing more than speculation to say that Yasuda laminates are elastic (as opposed to just being bendable).

The Appellants respectfully submit that hypothetically combining Yasuda with either or both of O'Brian and Kramer still fails to teach or suggest the subject matter as recited in Claims 38 - 51. The disclosure of Yasuda is nonenabling with respect to whether the laminates would have any application to dolls having articulated limbs. There is no disclosure on this point. The Yasuda disclosure is limited to a very brief reference to the fact that the laminates can have fabric bonded to the outmost resin layer to have a soft texture and a unique appearance effective, for example, "clothing for dolls" or other decorative elements. (Column 8, first full paragraph.) There is no mention at all concerning the type of dolls and whether they have articulated limbs. Thus, one of ordinary skill in the art would have no incentive to make the hypothetical combination with O'Brian which relates to dolls that do not have articulated limbs or to Kramer which also refers to planer shaped doll cutouts that do not have articulated limbs. Therefore, one of ordinary skill in the art would have no incentive to make the hypothetical combination.

In any event, even if one of ordinary skill in the art were to use the various materials disclosed by Yasuda as they apply to the specifics of Claims 38 - 51, the result would still be structures far different from those recited in Claims 38 - 51. For Example, applying the materials of Yasuda to the "clothes" of Kramer would still result in flat, planar doll's garments designed to adhere to flat, planar doll shaped cutouts disclosed by Kramer. Again, this has nothing to do with the invention as recited in Claims 38 - 51.

Similarly, even if one of ordinary skill in the art were to use the materials of Yasuda for O'Brian, the result would still be garments of the "snap-on" type that have nothing to do with the garments of Claims 38 - 51. In fact, one of ordinary skill in the art might very well likely hesitate to substitute the materials of Yasuda for the specific materials disclosed by O'Brian

because substitution of such materials might destroy the “snap-on” ability of those garments as contemplated by O’Brian.

In any event, hypothetically combining Yasuda with O’Brian and Kramer would still fail to teach or suggest flexible and elastic garments adapted to be fitted, dressed and removed from a garment in a life-like way when the doll has articulated limbs. Renewal of the rejection of Claims 38-51 based on Yasuda, O’Brian and Kramer is respectfully requested.

#### *Additional Arguments*

The Appellants were the first to invent the subject matter of Claims 20-23, 25, 26 and 28-51 and have licensed that subject matter to a well known toy manufacturer and enjoyed great commercial success, which is indicium of nonobviousness. Since the subject matter was licensed, this invention has revolutionized fashion play in small dolls and the licensee will have sold over \$440,000,000 worth of product around the world and over \$220,000,000 in the U.S. in five years by the end 2003. A chart of sales through 2004 is as follows:

<u>Year</u>	<u>Worldwide</u>	<u>USA</u>
1999	8	7.5
2000	30	15
2001	78	38
2002	127	62
2003	200	100
2004	172	95
Total	615	317.5



The above figures do not include sales of boy's figures to licensees other than the one mentioned above. To obtain the retail value of the above sales, it would be necessary to double or triple those figures (which are licensee's sales value). In other words, sales of product with molded elastic clothes that are the subject of the solicited claims have exceeded \$1 billion in five years at retail value worldwide.

Also, the product, sold under the name "Fashion Polly" (under the Polly Pocket brand), was awarded the coveted Toy of the Year by Mattel (the world's largest toy company). The product has single-handedly rescued a brand name (Polly Pocket) from the verge of extinction in 1999 and turned it around to be the best selling small doll in the world.

The undeniable commercial success of the product that is the subject of the license is because of the subject matter of Claims 20-23, 25, 26 and 28-51 and not due to inordinate quantities of advertising. In fact, the amount of advertising spent on the product is below the "spend to sales ratio" of competitive toys. Also, unlike many of its peer products in boy's and girl's toys, it has not been the subject of any cartoon or other entertainment support along with the usual merchandising campaigns (e.g., like a Disney property, or Barbie). In spite of below average expenditure of funds in marketing the product, it has been a resounding success and has spawned many attempts by others to enjoy the financial rewards provided the Appellants' advance in this art. There is no clearer proof of the non-obviousness of this product as set forth by the commercial success described above and the overt copying by others. A copy of a Declaration of one of the inventors that is already on the record is attached as Appendix B.

The Appellants also note that a wide variety of hypothetical combinations of different prior art disclosures have been hypothetically combined to reject the Claims 20-23, 25, 26 and 28-51. However, those hypothetical combinations have either not been appropriate or, even if

made, still fail to teach or suggest the invention of Claims 20-23, 25-26 and 28-51. Also, they rely on the notoriously tempting concept known as "hindsight." This technology is not especially complicated and is, therefore, susceptible to its use. However, hindsight is strictly forbidden, irrespective of the relative complexity of Claims 20-23, 25, 26 and 28-51.

The Court of Appeals for the Federal Circuit has decisively confirmed this point in its recent decision *In re Fritch*, 23 U.S.P.Q. 2d, 1780 (Fed. Cir. 1992). The CAFC has clearly prohibited hindsight:

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." 23 U.S.P.Q. 2d at 1783-1784.

The foregoing discussion is binding with respect to this application. It is impermissible to pick and choose portions of a disclosure and use hindsight reconstruction to reject the Claims 20-23, 25, 26 and 28-51.

The Appellants respectfully request that the rejection of Claims 20-23, 25, 26 and 28-51 accordingly be reversed as to all claims.

Respectfully submitted,



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## **APPENDIX A**

### **Listing of Claims**

Claims 1 – 19 (Cancelled)

20. (Previously Presented) The garment of claim 21 wherein said thermoplastic elastomer is selected from the group consisting of ethylene vinyl acetate copolymer, styrene-butadiene-styrene, styrene-isoprene-styrene, styrene-diene, styrene-isoprene-butylene block copolymers, styrene-isoprene-butylene block copolymers containing mineral oil, branched styrene copolymer, styrene butadiene, styrene-butadiene triblock, styrene-isoprene-styrene linear block polymer, styrene-butadiene radial block copolymer, and butadiene-styrene copolymer.

21. (Previously Presented) A garment comprising a flexible and elastic injection molded thermoplastic elastomer doll's garment having a molded shape to fit over, in a life-like way, external surfaces of at least a portion of a doll that has articulated limbs, has a through hole that accommodates passage of a doll's head or limb(s) and a wall thickness from 1 to 3 mm.

22. (Previously Presented) A garment comprising a flexible and elastic injection molded thermoplastic elastomer doll's garment having a molded shape to fit over, in a life-like way, external surfaces of at least a portion of a doll that has articulated limbs, has a through hole that accommodates passage of a doll's head or limb(s) and an average modulus of elasticity of less than 1 MN/M<sup>2</sup>.

23. (Previously Presented) The garment of claim 21, wherein said garment includes an integrally molded detail selected from the group consisting of a belt, a button, a ribbon, a bow, a cuff, a pocket, a lapel, and a collar.

24. (Cancelled)

25. (Previously Presented) The garment of claim 21, wherein said garment simulates clothing selected from the group consisting of a dress, a pair of dungarees, a jacket, a skirt, a vest, a pair of slacks, a hat, a coat, and a gown.

26. (Previously Presented) The garment of claim 21, further including a finish selected from the group consisting of paint, varnish, and glitter.

27. (Cancelled)

28. (Previously Presented) The garment of claim 21 wherein said garment is less than 8 cm in height.

29. (Previously Presented) The garment of claim 20 wherein said garment includes an integrally molded detail and said garment simulates clothing.

30. (Previously Presented) The garment of claim 21, wherein said garment has an average modulus of elasticity of less than 1 MN/m<sup>2</sup>.

31. (Previously Presented) The garment of claim 21, wherein the 100% modulus of elasticity is between 240 and 280 KN/m<sup>2</sup>.

32. (Previously Presented) The garment of claim 21, wherein the 300% modulus of elasticity is between 440 and 490 KN/m<sup>2</sup>.

33. (Previously Presented) A play set comprising a doll and a garment according to claim 21.

34. (Previously Presented) The play set of claim 33 wherein said doll is articulated at a joint selected from the group consisting of the shoulders, elbows, knees, neck, and hips.

35. (Previously Presented) The play set of claim 34 wherein said thermoplastic elastomer is selected from the group consisting of ethylene vinyl acetate copolymer, styrene-butadiene-styrene, styrene-isoprene-styrene, styrene-diene, styrene-isoprene-butylene block copolymers, styrene-isoprene-butylene block copolymers containing mineral oil, branched styrene copolymer, styrene butadiene, styrene-butadiene triblock, styrene-isoprene-styrene linear block polymer, styrene-butadiene radial block copolymer, and butadiene-styrene copolymer.

36. (Previously Presented) The play set of claim 35 wherein said garment includes an integrally molded detail.

37. (Previously Presented) The play set of claim 35 wherein said garment simulates clothing.

38. (Previously Presented) A play set comprising, in cooperative combination, a doll donned and fitted with a flexible and elastic injection molded garment which is molded to be removed, dressed and refitted again over external surfaces of the doll in a life-like way, the doll being articulated at a joint selected from the group consisting of the joints of the shoulders, elbows, knees, neck and hips, the garment has a through hole that accommodates passage of a doll's head or limb(s) and being molded from an elastomeric material selected from the group consisting of ethylene vinyl acetate copolymer, styrene-butadiene-styrene, styrene-isoprene-styrene, styrene-diene, styrene-isoprene-butylene block copolymers containing mineral oil, branched styrene copolymer, styrene butadiene rubber, styrene-butadiene triblock rubber, styrene-isoprene-styrene linear block polymer, styrene-butadiene radial block copolymer, butadiene-styrene copolymer rubber, the garment having a wall thickness from 1 to 3 mm and an average modulus of elasticity of less than 1 MN/m<sup>2</sup>.

39. (Previously Presented) The play set of claim 38, wherein the garment includes at least one integrally molded detail.

40. (Previously Presented) The play set of claim 39, wherein said detail is selected from the group consisting of: a belt, a button, and a collar for the garment.

41. (Previously Presented) The set of claim 38, wherein said garment has a 100% modulus of elasticity between 120 and 350 KN/m<sup>2</sup>.

42. (Previously Presented) The set of claim 39, wherein said garment has a 100% modulus of elasticity between 240 and 280 KN/m<sup>2</sup>.

43. (Previously Presented) The set of claim 38, wherein said garment has a 300% modulus of elasticity between 440 and 490 KN/m<sup>2</sup>.

44. (Previously Presented) The set of claim 38, which comprises a plurality of seamless garments each being adapted to be removed and refitted to the doll.

45. (Previously Presented) The set of claim 38, wherein the garment is a dress, a pair of dungarees, a jacket, a skirt, a vest, a pair of slacks, a hat or a coat.

46. (Previously Presented) The set of claim 38, wherein the material of the garment has a decorative coating of paint or varnish.

47. (Previously Presented) A doll's flexible and elastic garment which is adapted to be dressed, fitted and be removed from a doll in a life-like way, said garment comprises a flexible and elastic injection molded elastomeric copolymer material selected from the group consisting of ethylene vinyl acetate copolymer, styrene-butadiene-styrene, styrene-isoprene-styrene, styrene-diene, styrene-isoprene-butylene block copolymers containing mineral oil, branched styrene copolymer, styrene butadiene, styrene-butadiene triblock, styrene-isoprene-styrene linear block polymer, styrene-butadiene radial block copolymer, butadiene-styrene copolymer, the garment having a molded shape to fit over external surfaces of at least a portion of the doll that has articulated limbs and a wall thickness from 1 to 3 mm, said garment having an average modulus of elasticity of less than 1 MN/m<sup>2</sup>, has a through hole that accommodates passage of a doll's head or limb(s).

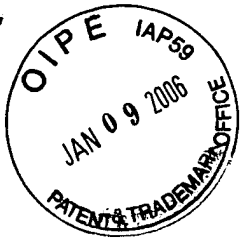
48. (Previously Presented) The doll's garment of claim 47 further including at least one integrally molded detail.

49. (Previously Presented) The garment of claim 48 wherein said detail is selected from the group consisting of: a belt, a button, and a collar for the garment.

50. (Previously Presented) The doll's garment of claim 49 wherein said garment has a 100% modulus of elasticity between 120 and 350 KN/M<sup>2</sup>.

51. (Previously Presented) The doll's garment of claim 50 wherein said garment has a 100% modulus of elasticity between 240 and 280 KN/M<sup>2</sup>.





## APPENDIX B

Copy of Declaration of Mr. Casey William Norman

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Art Unit : 3712	Customer No.: 035811
Examiner : Faye Francis	
Serial No. : 09/844,322	
Filed : April 26, 2001	
Inventors : Casey William Norman	Docket No.: 1391-CON-00
: Torquil Patrick Alexander Norman	Confirmation No.: 1969
Title : DOLL'S CLOTHING	

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**Declaration of Mr. Casey William Norman**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

I, Casey William Norman, declare that I reside at Thornhill, Withington Road, Andoversford, Gloucestershire GL54 4LL, United Kingdom. I worked for the UK company Bluebird Toys plc for seven years, the last four of those as Development Director. Subsequently I founded the company Genie Toys plc in 1996, in which I currently serve as its Managing Director.

I am a co-inventor of the above-identified Application. I am familiar with the Official Action dated September 24, 2003 and have thoroughly studied the prior art used to reject the claims in the Application. As a result of my long experience in the toy industry, I can unequivocally state that the prior art utilized to reject the claims in the Application does not render those claims obvious. Rejection of the claims is based on the use of hindsight, not actual teachings or suggestions gleaned from the prior art.

The subject matter of the claims in this Application has been commercialized. That commercialization has been a resounding success beyond my expectations. That commercial success resulted from the inventive features of this invention and not from advertising or promotional efforts beyond standard efforts consistent with industry norms. In other words, products that have been commercialized based on the subject matter claimed in this Application have enjoyed commercial

success far beyond what could reasonably be expected compared to other toy products with the same investment in advertising and promotional dollars.

The subject matter that is claimed in this Application has been licensed to a well known toy manufacturer. That subject matter has revolutionized fashion play in small dolls. As a result, the licensee has sold over \$440,000,000 of product around the world and over \$220,000,000 in the United States within the last five years (calculated through the end of this year). A Table indicating the sales for years 1999 through 2003 is set forth below.

<u>Year</u>	<u>Worldwide</u>	<u>USA</u>
1999	8	7.5
2000	30	15
2001	78	38
2002	127	62
2003	200	100
Total	443	222.5

It is important to note that the sales figures set forth above do not include sales of boys' doll figures to licensees other than the licensee mentioned above. Also, to obtain the retail value of the above sales figures, it would be necessary to increase substantially the numbers in the Table. (Those numbers would be the licensee's reported sales value.) Thus, sales of product within the scope of the claims of this Application may have exceeded one billion dollars in five years at retail value worldwide.

The product mentioned above has been sold under the name "Fashion Polly" (under the Polly Pocket brand). This product was awarded the "Girl's Inventor Product of the Year" by Mattel, which

is the world's largest toy company. This is an important award in the industry and is highly sought after. The features of the product, the way in which it has transformed the small dolls segment of the industry and the rapid increase in sales indicate the importance of the advance this invention has brought about. In fact, this single product innovation has rescued a brand name (Polly Pocket) from the verge of extinction in 1999. Polly Pocket is now the bestselling small doll in the world as a consequence of the molded elastic clothes product that is the subject matter of the claims of this Application.

As I noted above, the amount of advertising and promotional efforts spent on the product is actually below the "spend-to-sales ratio" of competitive toys. Further, it is different from many peer products in girls and boys' toys because it has not been the subject of any cartoon or other entertainment support or typical merchandising campaigns (for example, such as are typical of Disney properties).

Finally, one of the best indicators of the advance made by this product is the fact that the product is now being copied by other toy manufacturers in an effort to share in the financial success brought about by this product.

The undersigned declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and thus such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 16<sup>th</sup> December 2003

Casey William Norman  
Casey William Norman, co-inventor